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Peter Sullivan
Hughes Hubbard & Reed LLP
One Battery Park Plaza
New York, NY 10004-1482

EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

Office Action Summary

Application No.

09/675,958

Applicant(s)

KUSUMOTO ET AL.

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 6) ☐ Other: _____.

DETAILED ACTION

Examiner's Amendment

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.
2. Authorization for this examiner's amendment was given in a telephone interview with Ronald Abramson (Reg. No. 34,762) on 9/8/2003.
3. Independent Claim 31 has been separated and identified, and the claims following independent Claim 31 have been renumbered from Claims 31-63 to Claims 32-64.

Applicant Fees

4. Applicant submitted incorrect Fee Transmittal statement on 9/28/2000. The application was originally filed with an error in the claim structure and numbering. The error has been corrected through an examiner's amendment and now contains 64 Claims and 5 independent Claims (1, 15, 31, 45, and 59). The applicant paid fees for 63 claims and 3 independent claims. The Applicant should resubmit the additional fees for the extra Claim and two extra independent Claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-7, 15-23, 31-37, 45-51, 59-62, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (US 6,036,601) in view of Avaterra (www.avaterra.com, retrieved from Internet Archive Wayback Machine <www.archive.org>, page range 11/29/1999-5/12/2000).**
7. As per independent Claims 1, 31, and 45, Heckel discloses a method of advertising to participants and viewers in a virtual world; and displaying said advertisement to other participants and viewers in said virtual world (abstract).
8. Heckel fails to expressly disclose the steps of enabling at least one participant in said virtual world to select an advertisement.
9. However, Avaterra teaches creating a virtual world with avatars, wherein the users can personalize their users by selecting clothing and accessories (www.avaterra.com).
10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the steps of enabling at least one participant in said virtual world to select an advertisement, as disclosed by Avaterra in the system disclosed by Heckel, for the advantage of providing a method of advertising to participants and viewers in

a virtual world, with the ability to increase brand awareness and brand imaging by allowing users to select and display the advertisements (brand) on their avatars.

11. As per Claims 2, 32, and 46, Heckel and Avaterra disclose wherein said advertisement is associated with said participant by displaying said advertisement on an avatar of said participant within said virtual world (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40) (www.avaterra.com).
12. As per Claims 3, 33, and 47, Heckel and Avaterra disclose wherein said advertisement is associated with said participant by displaying said advertisement on a virtual space of said participant within said virtual world (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).
13. As per Claims 4, 34, and 48, Heckel and Avaterra disclose wherein said advertisements are associated with said participant by displaying said advertisement on a virtual object of said participant within said virtual world (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40) (www.avaterra.com).
14. As per Claims 5, 35, and 49, Heckel and Avaterra disclose wherein said virtual world is implemented by interactive media (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).
15. As per Claims 6, 36, and 50, Heckel and Avaterra disclose wherein said interactive media is provided by at least one server on a computer network (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).

Art Unit: 3629

16. As per Claims 7, 37, and 51, Heckel and Avaterra disclose wherein said interactive media is provided by interactive television (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).
17. As per independent Claim 15, Heckel discloses a method of tracking activities of at least one participant in a virtual world in connection with displaying advertisement to other participants and viewers in said virtual world, which comprises: collecting information on said participant; collecting information on one or more advertisements; and collecting display information on how said advertisement was displayed to other participants and viewers in said virtual world (C3 L4-16, C5 L1-40).
18. Heckel fails to expressly disclose wherein the participant selects and displays the advertisement.
19. However, Avaterra teaches creating a virtual world with avatars, wherein the users can personalize their users by selecting clothing and accessories (www.avaterra.com).
20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the participant selects and displays the advertisement, as disclosed by Avaterra in the system disclosed by Heckel, for the advantage of providing a method of advertising to participants and viewers in a virtual world, with the ability to increase brand awareness and brand imaging by allowing users to select and display the advertisements (brand) on their avatars.
21. As per Claim 16, Heckel and Avaterra disclose wherein said display information comprises: measured display time of said advertisement to other participants and viewers; and a number

of participants and viewers that viewed said advertisement (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).

22. As per Claim 17, Heckel and Avaterra disclose wherein said display information comprises: anticipated display time of said advertisement to other participants and viewers; a size of said advertisement; and a location of said advertisement for display (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).
23. As per Claim 18, Heckel and Avaterra disclose recording said activities of said participant in connection with said advertisement in appropriate databases (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40) (www.avaterra.com).
24. As per Claim 19, Heckel and Avaterra fail to expressly disclose rewarding said participant in connection with activities identified in said tracking step.
25. However, Heckel does teach tracking the viewing statistics of advertisements on users in the virtual world, wherein the adserver then uses the statistical information to for billing the advisor (C3 L4-16).
26. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included rewarding said participant in connection with activities identified in said tracking step, in the system disclosed by Heckel in view of Avaterra, for the advantage of providing a method of advertising to participants and viewers in a virtual world, with the ability to increase customer interaction with the advertising process by offering a tangible incentive.

Art Unit: 3629

27. As per Claim 20, Heckel and Avaterra disclose billing advertisers in connection with activities identified in said tracking step (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).
28. As per Claim 21, Heckel and Avaterra disclose wherein said virtual world is implemented by interactive media (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).
29. As per Claims 22, Heckel and Avaterra disclose wherein said interactive media is provided by at least one server on a computer network (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).
30. As per Claims 23, Heckel and Avaterra disclose wherein said interactive media is provided by interactive television (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40) (www.avaterra.com).
31. As per independent Claim 59, Heckel discloses a system for advertising and branding in a virtual world comprising: a computer network, wherein a networked virtual environment exists and is accessible by multiple participants simultaneously; and at least one server on said computer network maintaining several databases comprising a consumer database (abstract, C4 L35-68), an advertising database, and a presentation tracking database wherein said consumer database stores profiles of consumers who have participated or have expressed an intention to participate in said networked virtual environment (C3 L4-16); said advertisement database contains identification for each advertisement; and said presentation tracking database stores participant and viewer exposure information of said advertisement (C3 L4-16, C5 L1-40).

Art Unit: 3629

32. Heckel fails to expressly disclose wherein the advertising is selected and displayed by the consumer.
33. However, Avaterra teaches creating a virtual world with avatars, wherein the users can personalize their users by selecting clothing and accessories (www.avaterra.com).
34. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the advertising is selected and displayed by the consumer, as disclosed by Avaterra in the system disclosed by Heckel, for the advantage of providing a method of advertising to participants and viewers in a virtual world, with the ability to increase brand awareness and brand imaging by allowing users to select and display the advertisements (brand) on their avatars.
35. As per Claim 60, Heckel and Avaterra disclose a billing system, wherein said exposure information stored in said presentation tracking database is used to generate information to bill advertisers (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).
36. As per Claim 61, Heckel and Avaterra disclose wherein said consumer database comprises registration information, environment continuation information to allow said participants to continue where said participants previously left said networked virtual environment, and information on said participant's recent activities (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40) (www.avaterra.com).
37. As per Claim 62, Heckel and Avaterra disclose wherein information stored in said consumer database may also be used to allow said advertisers to modify said advertiser's advertisements and reward offers (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40) (www.avaterra.com).

Art Unit: 3629

38. As per Claim 64, Heckel and Avaterra disclose wherein said presentation tracking database contains information on total exposure time of said advertisement and amount of exposure to other participants and viewers in said virtual environment (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).
39. **Claims 8-14, 24-30, 38-44, 52-58, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (US 6,036,601) in view of Avaterra, and further in view of Ferreira (US 2001/0034661 A1).**
40. As per Claims 8-10, 24-26, 38-40, 52-54, and 63, Heckel and Avaterra fail to expressly disclose wherein said advertisement comprises text, symbols, or graphs (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).
41. However, Ferreira teaches advertising in a virtual world, which contains text, symbols or graphs (Para 0018, Para 0061, Para 0077, Para 0088, Para 0093, Para 0105).
42. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein said advertisement comprises text, symbols, or graphs, as disclosed by Ferreira in the system disclosed by Avaterra, in the system disclosed by Heckel, for the advantage of providing a method of advertising to participants and viewers in a virtual world, with the ability to increase customer attentions to advertisements by increasing advertisement features.
43. As per Claims 11, 27, 41, and 55, Heckel, Avaterra and Ferreira disclose wherein said advertisement is texture-mapped in said virtual world (Ferreira: Para 0018, Para 0061, Para 0077, Para 0088, Para 0093, Para 0105).

Art Unit: 3629

44. As per Claims 12, 28, 42, and 56, Heckel, Avaterra and Ferreira disclose wherein said advertisement comprises multimedia elements taken from the group of audio, video and animation (Ferreira: Para 0018, Para 0061, Para 0077, Para 0088, Para 0093, Para 0105).
45. As per Claims 13, 29, 43, and 57, Heckel, Avaterra and Ferreira disclose wherein said multimedia elements are played at times designated by said participant (Ferreira: Para 0018, Para 0061, Para 0077, Para 0088, Para 0093, Para 0105) (www.avaterra.com).
46. As per Claims 14, 30, 44, and 58, Heckel, Avaterra and Ferreira disclose wherein said multimedia elements are played at predetermined times (Ferreira: Para 0018, Para 0061, Para 0077, Para 0088, Para 0093, Para 0105).

Conclusion

47. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
48. The following foreign patent is cited to show the best foreign prior art found by the examiner:

Japanese Pat. No. JP 2001147881 A to Nakano

Nakano discloses an advertisement distribution system for allowing the avatar of a user to advertise merchandise on the Internet, and for giving a consideration to the user of the avatar in charge of the advertisement activity.

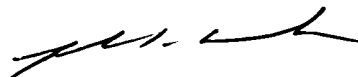
Art Unit: 3629

49. Additional Non-Patent Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
50. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
51. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.
52. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.



jo

September 10, 2003



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600